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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/000,091	12/04/2001	Jeong Gun Lee	041501-5485	8023

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EXAMINER

FORMAN, BETTY J

ART UNIT	PAPER NUMBER
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1634

DATE MAILED: 03/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

8-17

Advisory Action

Application No.

10/000,091

Applicant(s)

LEE ET AL.

Examiner

BJ Forman

Art Unit

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 17 February 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☒ Applicant's reply has overcome the following rejection(s): See Attached Continuation of Advisory Action.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because:
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:


Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-9.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s): _____.
10. ☐ Other: _____


BJ Forman
Primary Examiner
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CONTINUATION OF ADVISORY ACTION

Applicant's reply has overcome the following rejection(s): 35 U.S.C. 102(e) over Lee et al U.S. Patent No. 6,342,359 and the obviousness-type double patenting over the '359 patent.

Response to Arguments

Applicant argues that Hashimoto et al do not teach the instantly claimed "chip" but instead teach embodiments wherein their base plate is a 5cm² graphite or glass plate. Applicant further argues that The American Heritage Dictionary defines a "chip" as "a minute slice of a thin semiconducting material processed to have specified electrical characteristics". The arguments have been considered but are not found persuasive for the following reasons.

First, as stated in the Final Office Action, the courts have stated that claims must be given their broadest reasonable interpretation consistent with the specification *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997); *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-551 (CCPA 1969); and *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) (see MPEP 2111).

The instant specification broadly defines a DNA chip at paragraphs 5-6 as cited below: "A DNA chip is developed, in which a two dimensional array of nucleic acids disposed onto solid substrate at known positions. The DNA chip permits search of genes from a few hundreds at the smallest, and to more than 400,000, quickly. The DNA chip, having an array of high concentration DNA fragments with a great variety of base sequences on a small substrate surface, is used for obtaining information of DNA in an unknown sample by hybridization with an immobilized DNA and a complementary DNA in the unknown sample."

Hashimoto et al teach a "base plate" comprising immobilized nucleic acid probes at known positions wherein the number of positions having the immobilized probes is not restricted (Column 26, line 61-Column 27, line 22 and Example 31). As such, the base plate of Hashimoto et al as encompassed by the instantly claimed chip as broadly defined by the specification. However, it is noted that limitations from the specification cannot be read into the claims (See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993)), the base plate of Hashimoto et al meets the broad definition of chip as recited in the specification.

Second, Applicant's definition of "chip" from The American Heritage Dictionary is the "electronics" definition. The instant claims are not limited to an electronic chip. Hence, Applicant's assertion that the "electronics" definition defines the instantly claimed chip is not

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appropriate. As stated above, the courts have stated that the claims must be given their broadest reasonable interpretation in view of the specification. It is noted that The American Heritage Dictionary further defines "chip" as "a small piece". Hashimoto et al defines their base plate as a "small" (and/or minute) piece because they teach their preferred base plate has a size ranging from 1 to 100 μ m (Column 12, lines 22-25). Therefore, Hashimoto teaches the "chip" as defined by the American Heritage Dictionary. Furthermore, while Applicant's asserted definition of "chip" is not considered a limitation of the instantly claimed chip, Hashimoto et al teach the chip has specified electrical characteristics i.e. their base plate is an electrode (Column 8, lines 38-59). Therefore, even if the claims were amended to limit the chip to the definition provided by The American Heritage Dictionary, the claims would still be anticipated by Hashimoto et al.

Finally, Applicant points to the 5cm² embodiment to illustrate that the base plate of Hashimoto et al is not "exceptionally small or tiny". In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., exceptionally small or tiny chip size) is not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Furthermore, as stated above, Hashimoto clearly teaches tiny i.e. from 1 to 100 μ m (Column 12, lines 22-25). The fact that Hashimoto teaches and embodiment wherein the plate is 5cm² does not negate the fact that they teach the "tiny" size as argued (but not claimed).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BJ Forman whose telephone number is (571) 272-0741 until 13 January 2004. The examiner can normally be reached on 6:00 TO 3:30 Monday through Thursday and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on (703) 308-1119. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 308-8724 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-0507.



BJ Forman, Ph.D.
Primary Examiner
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February 26, 2004